

Appl. No. 10/028,726
Amdt. dated March 3, 2005
Reply to Office Action of December 3, 2004

PATENT

REMARKS/ARGUMENTS

Claims 49-56 are pending in the present application. The claims remain rejected under 35 U.S.C. §102(f) for allegedly being invented by another. The claims were also rejected under the doctrine of obviousness-type double patenting for allegedly being obvious over the claims of US Patent No. 5,532,220.

Rejection under 35 U.S.C. § 102(f)

The claims remain rejected for allegedly being invented by Lee and Chen, who are the inventors on US Patent No. 5,532,220. As noted previously, the claims of the '220 patent are directed to treatment of cancer cells lacking wild-type p53 by introducing a wild-type p53 gene into the cells. In the Office Action, the Examiner asserts that "p53 is a portion of the RB gene." The Examiner provides no evidence to support this statement. Applicants are not aware of any publication that makes such a claim. In the absence of evidence that p53 is indeed a portion of RB, the rejection cannot be maintained.

The claims also remain rejection under 35 U.S.C. § 102(f) for allegedly being the invention of Lee, Huang, Lee, Friedmann and Yee. The basis for this rejection is the fact that applicant's Petition under 37 CFR §1.48 has been dismissed on formal grounds. Applicants attach a copy of the Response to Decision on the Petition mailed February 10, 2005. The enclosed Response addresses the reasons for dismissal of the petition. Upon granting of the petition, withdrawal of the rejection is respectfully requested.

Double Patenting Rejection

The double patenting rejection of the claims over the claims of the '220 patent are respectfully traversed. In the present rejection, the Examiner asserts that the p53 is a portion of the RB gene. As noted above, the Examiner provides no evidence to support this rejection. In the absence of evidence to the contrary, applicants again note that the claims of each patent are directed to use of a different tumor suppressor gene to treat a different class of cancer cells. The Examiner has provided no reasoning or evidence to show how use of p53 would lead one of skill to the present invention. In the absence of such a showing the rejection is improper and should be withdrawn.

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CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested. If a telephone conference would expedite prosecution of this application, the Examiner is invited to telephone the undersigned at 415-576-0200.

Respectfully submitted,


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